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EXAMINER

ROSEN, NICHOLAS D

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 08/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/853,541

Applicant(s)

TEDESCO ET AL.

Examin r

Nicholas D. Rosen

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-- Th MAILING DATE of this communication appears on th cov r sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 79-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 79-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Claims 79-103 have been examined.

***Drawings***

The corrected or substitute drawings were received on March 31, 2003 (filed March 27). These drawings are acceptable to the Examiner and the Draftsperson.

***Affidavit Pursuant to 37 CFR 1.131***

The affidavit filed on March 27, 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the Goldenberg reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Goldenberg reference to either a constructive reduction to practice or an actual reduction to practice. The affidavit merely asserts the applicants' diligence in working to draft and file [the patent application which is now] U.S. Patent 6,282,523, of which the present application is a continuation. See MPEP 715.07(a).

It is also necessary to document attorney's diligence in preparing a patent application, and the affidavit filed March 27, 2003 does not clearly assert, still less provide facts to support, that patent counsel acted with diligence in preparing and filing [the patent application which is now] U.S. Patent 6,282,523, of which the present application is a continuation. See MPEP 2138.06.

***Claim Objections***

Claim 90 is objected to because of the following informalities: In the eighth line of claim 90, the word "check" should be followed by a comma rather than a semicolon. Appropriate correction is required.

Claims 91-102 are objected to because of the following informalities: In the eighth line of claim 91, the word "check" should be followed by a comma rather than a semicolon. Appropriate correction is required.

Claim 103 is objected to because of the following informalities: In the tenth line of claim 103, the word "check" should be followed by a comma rather than a semicolon. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 91-102 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 91 recites the limitation "transmitting the code to a payee of the check," which is not supported by the specification. Instead, the specification teaches that a payee of the check transmits the code to the payor's bank.

Claim 103 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 91 recites the limitation "transmitting the code to a payee of the check," which is not supported by the specification. Instead, the specification teaches that a payee of the check transmits the code to the payor's bank.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 79 and 82 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldenberg (U.S. Patent 6,036,344). As per claim 79, Goldenberg discloses a method, comprising: receiving a code (Abstract; column 3, line 61, through column 4, line 31); and determining from the code an amount of funds reserved for payment with a predetermined check (Abstract; column 4, lines 50-58). (The second step is inherent, since it would not be possible to determine whether there were sufficient funds in the

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account to be drawn against without determining from the code the amount of funds for which the check had been written.)

As per claim 82, Goldenberg discloses transmitting a message including the amount of funds (Abstract; column 3, line 1, through column 4, line 31; column 4, lines 50-58). Again, it is inherent that the message includes the amount of funds, since without the amount of funds, it would be impossible to determine whether there were sufficient funds in the account to be drawn against.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 80, 81, and 83**

Claims 80 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldenberg as applied to claim 79 above, and further in view of official notice. As per claim 80, Goldenberg does not expressly disclose that receiving the code comprises receiving DTMF signals, but does disclose using the telephone network (column 4, lines 19-24), and official notice is taken that the use of DTMF signals in the telephone network is well known. (See Jones et al., U.S. Patent 5,797,133, Abstract, for an example.) Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have receiving the code comprise receiving DTMF signals, for the obvious advantage of receiving the code by a common, well-known technique, for which appropriate apparatus is readily available.

As per claim 81, Goldenberg does not expressly disclose that receiving the code comprises receiving the code via a World Wide Web site, but does disclose using the Internet (column 3, lines 13-19; column 4, lines 19-24), and official notice is taken that use of World Wide Web sites is well known. (See Lebda et al., U.S. Patent 6,385,594, Abstract, for an example.) Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to receive the code via a World Wide Web site, for the obvious advantage of receiving the code through a common, widely available means, which would have been familiar and accessible to many potential users.

Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldenberg as applied to claim 79 above, and further in view of Bezy et al. (U.S. Patent 5,703,344). Goldenberg does not expressly disclose storing an indication that the

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predetermined check has been claimed, but Bezy teaches this (column 5, lines 11-33).

Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to store an indication that the predetermined check had been claimed, for the stated advantage of preventing a forger from presenting a forged check with the same serial number.

### **Claims 84-89**

Claims 84 and 87-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldenberg (U.S. Patent 6,036,344) in view of Bezy et al. (U.S. Patent 5,703,344). As per claim 84, Goldenberg discloses a method, comprising: receiving data that includes an account identifier that indicates a financial account (column 3, lines 20-36), and an amount of funds (inherent from Abstract and column 4, lines 50-58, since the processing center could not determine whether there were sufficient funds in the account to be drawn against, without being informed of the amount of funds); making the amount of funds unavailable for use in the financial account (Abstract; column 4, lines 50-58); generating a code that indicates the check (column 3, line 6, through column 4, line 2; column 5, lines 12-33); transmitting the code (column 4, lines 7-31); receiving the code (column 4, lines 16-24 and 50-58); determining the data based on the code (column 4, lines 50-58); and transmitting a message that indicates the amount of funds (Abstract; column 4, lines 16-26 and 50-58). Goldenberg does not disclose that the data includes a check identifier that indicates a check drawn on the financial account, but Bezy teaches this (column 5, lines 20-33). Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to



have the data include a check identifier that indicates a check drawn on the financial account, for the stated advantage of avoiding paying on stolen or forged checks, and for the obvious advantage of being able to match provisional debits against the particular checks which resulted in the provisional debits when the checks are cleared.

Arguably, Goldenberg's method could be viewed as not generating a code that indicates the check in that it is not expressly disclosed as indicating the check serial number, etc., but Bezy does teach indicating the check in that sense (column 5, lines 20-33). Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to have the code indicate the check, for the stated advantage of avoiding paying on forged or stolen checks, and for the obvious advantage of being able to match provisional debits against the particular checks which resulted in the provisional debits when the checks are cleared.

As per claim 87, Goldenberg discloses encrypting at least some data (column 3, lines 6-19; column 3, line 30, through column 4, line 2).

As per claim 88, Goldenberg discloses that transmitting the code comprises transmitting the code to a first device (column 4, lines 16-24 and 50-58); and that the step of receiving the code comprises receiving the code from a second device (column 4, lines 16-24).

Claims 85, 86, and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldenberg and Bezy as applied to claim 84 above, and further in view of official notice. As per claim 85, Goldenberg does not expressly disclose that receiving the code comprises receiving DTMF signals, but does disclose using the

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telephone network (column 4, lines 19-24), and official notice is taken that the use of DTMF signals in the telephone network is well known. (See Jones et al., U.S. Patent 5,797,133, Abstract, for an example.) Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have receiving the code comprise receiving DTMF signals, for the obvious advantage of receiving the code by a common, well-known technique, for which appropriate apparatus is readily available.

As per claim 86, Goldenberg does not expressly disclose that receiving the code comprises receiving the code via a World Wide Web site, but does disclose using the Internet (column 3, lines 13-19; column 4, lines 19-24), and official notice is taken that use of World Wide Web sites is well known. (See Lebda et al., U.S. Patent 6,385,594, Abstract, for an example.) Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to receive the code via a World Wide Web site, for the obvious advantage of receiving the code through a common, widely available means, which would have been familiar and accessible to many potential users.

As per claim 89, Goldenberg discloses transmitting the message by making a telephone call (column 7, line 58, through column 8, lines 2-7), and official notice is taken that making a telephone call generally comprises transmitting an audio message. Hence, it would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention to transmit an audio message, for the stated advantage of

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conveying a message where other means for doing so, such as computer-to-computer transmission involving a processing center, were not available.

### **Claim 90**

Claim 90 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldenberg (U.S. Patent 6,036,344) in view of official notice. Goldenberg discloses a method comprising: receiving data that includes: an identifier of an account (Abstract; column 3, lines 31-47), an identifier of a check drawn on the checking account (implied by column 5, lines 30-33, official notice being taken that the information currently used to route checks through the banking system normally includes a check identifier), and an amount of funds associated with the check (inherent from Abstract and column 4, lines 50-58, since it would not be possible to determine whether there were sufficient funds in the account to be drawn against, and to provisionally debit the account, unless the check data included the amount of funds for which the check had been written). Goldenberg further discloses making the amount of funds in the account unavailable for use by the payor (Abstract; column 4, lines 50-58); generating a code associated with the check, wherein the code is generated based on at least one of the identifier of the account, the identifier of the check, and the amount of funds (Abstract; column 3, lines 30-60) and transmitting the code (column 4, lines 16-24). It would have been obvious to one of ordinary skill in the art of finance at the time of applicant's invention for the data to include an identifier of a checking account, for the obvious advantage of applying Goldenberg's invention to standard checks, whose routing information includes check identifiers.

***Response to Arguments***

Applicants' arguments filed March 27, 2003, have been fully considered but they are not persuasive. First, Applicants' Affidavit pursuant to 37 C.F.R. 1.131 had been found ineffective, as set forth above. Secondly, Applicants argue that Goldenberg teaches a system and method "for countering fraudulent check *cashing* schemes" [Applicants' emphasis] for banks, while Applicants' system permits check payors to provide payees assurance by reserving a check amount. Examiner replies that, particularly with regard to the 35 U.S.C. 102 rejections, it is sufficient that the prior art (in this case Goldenberg), teaches the claimed limitations. It is not necessary for Goldenberg to teach a method which carries out the claimed limitations in precisely the same context as in Applicants' inventive concept, especially if the context is not found anywhere in Applicants' claims. It is proper, in examining patent claims, to give them their broadest reasonable interpretation. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that the context in which their invention is to be used is not the same as Goldenberg's, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative

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difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As to new claims 90-103, they are not properly supported by the specification.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Japanese Published Patent Application 8-212268, to Tanaka et al., made of record by Applicants in their IDS, paper #4, discloses a method identifying a bank customer by his bank card.

The article "Check the Checks You're Offered to Cut Losses from Bad Paper" (abstract only) discloses that a certified check is guaranteed by the bank, so that funds are available.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687 for regular communications and for After Final communications (soon to be superseded by 703-872-9306).

The new mailing address for the Patent Office is:

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As of May 1, 2003, the former addresses, Washington DC 20231 and P.O. Box 2327 Arlington VA 22202, should **not** be used.

Papers can be hand-delivered to the Technology Center 3600 receptionist, 7<sup>th</sup> floor, Crystal Park 5, 2451 Crystal Drive, Arlington VA 22202.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

*Nicholas D. Rosen*  
**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

August 11, 2003